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Supreme Court of the United States

OCTOBER TERM, 1978

No. 78-1304

AMERICAN SEATING COMPANY,

Petitioner,

v.

NATIONAL SEATING COMPANY,

Respondent,

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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I.

OPINIONS BELOW

The opinions in this case by the Northern District of Ohio, Eastern Division and the Sixth Circuit Court of Appeals are properly noted in the Petition and included in Petitioner's appendix. However, the Petition for Certiorari, while mentioning the Sixth Circuit's denial of a Petition for Rehearing, did not indicate that such Petition for rehearing was based upon substantially the same arguments now being advanced. In denying rehearing, the Sixth Circuit held as follows:

> Upon consideration of the Petition for rehearing we are of the view that the issues of this case were adequately treated in our opinion and that there is no merit in the petition for rehearing. (RA 1)

II.
QUESTIONS PRESENTED FOR REVIEW

The four questions presented by the Petition are based upon Petitioner's interpretation of extremely limited portions of the record, which interpretation is inconsistent with specific findings of the District and Appellate Courts and with the extensive record of this case. Removing Petitioner's improper interpretation of the record and the arguments based thereon, the sole issue presented by the Petition is as follows:

> In the well developed factual context of the record presented by this case, is the opinion by the 6th Circuit, which affirmed en toto the opinion of the District Court, that U.S. Patent No. 3,729,226 ('226 patent) is invalid, as being anticipated (35 U.S.C. § 102,) obvious (35 U.S.C. § 103) and indefiinite (35 U.S.C. § 112), inconsistent with opinions in other circuits and/or with other opinions by this Court?

Respondent, National Seating Co. ("National"), respectfully submits that there is no such inconsistency and that the Petition should accordingly be denied.

III.
STATEMENT OF THE CASE

The '226 patent (A30) discloses a transit bus chair including two fixed back seats mounted on a beam frame supported by a connection to the bus wall at one end and by a pedestal at its center. Such pedestal is of inverted T configuration and includes an upright column (of undisclosed construction) connected to the beam frame at its top and connected to a tubular foot at its bottom. The tubular foot is secured to the floor by fasteners passing through the base plate, with the fasteners being selectively concealed by removable covers. The only advantages alleged for such transit bus chair in the '226 patent were

maximum clearance between chairs, improved floor cleaning, and increased leg room and storage space beneath the chairs.

After nine days of trial with over 1,500 pages of trial transcript and over 125 exhibits, the District Court specifically compared the structure of the '226 patent to the prior art structure and found that all the '226 claim elements were old (All, 12), that the '226 claimed combination was old (All), that all the advantages for the chair alleged in the '226 patent were old (A8, 9), that the transit chair claimed did not provide a synergistic result (A13) and that the prior art introduced at trial was better than the prior art considered by the Patent Office thereby weakening the presumption of validity (A13). These findings of fact were affirmed by the Sixth Circuit on the bases that they were supported by substantial evidence and were not clearly erroneous (A25-28)[1]. These findings properly provide the foundation for the holdings that the prior art anticipates and makes obvious the claimed invention and that the claimed invention is invalid for indefiniteness (A17, 29).

With respect to the prior art, the courts primarily relied upon National's Greyhound Tour Coach chair sold in 1956 (DXAQ, BA, RA 2) and American's round base

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[1] After comparing the prior art advanced at trial to the prior art cited by the Patent Office, the Sixth Circuit went one step further and found the presumption of validity totally destroyed "because the concepts embodied in the uncited prior art possess the most relevance in the determination of patentability . . ." (A23) Petitioner obviously knew about its own prior art round base chair but failed to call the Patent Office's attention to the same. Petitioner's failure to disclose this prior art chair to the Examiner does not meet its "uncompromising duty of disclosure" to the Patent Office, thereby to establish still another basis for invalidity or unenforceability of the '226 patent. *Charles Pfizer & Co. v. FTC*, 401 F.2d 574, (6th Cir. 1968), *cert. den.* 393 U.S. 1022 (1969), and *Buzelli v. Minnesota Mining & Manufacturing Co.*, 521 F.2d 1162, 1166 (6th Cir. 1975).

chair sold in 1969 (DXEJ, TA, RA 3). Compared to the '226 patented chair, such American round base chair included identical seats mounted on an identical frame supported by an identical wall connection and a round base pedestal positioned at an identical center position relative to the frame, all as admitted by the patentee (A9). Such center round base pedestal, which was previously used for lecture room seating (RA4), included a hollow tubular upright connected at its top to the beam frame and connected at its bottom to a round plate forming the foot. Such foot was secured to the floor by fasteners passing therethrough, with the fasteners being selectively concealed by removable covers. Contrary to Petitioner's arguments that significant differences exist between such round base chair and the bus chair claimed in the '226 patent (Pet. at 10), the District Court and Appellate Court both specifically found that the only difference between these chairs was in the shape of their feet, i.e. round vs. tubular. (A9, 25-6) The Courts then went on to find that this was no difference at all since the two pedestals were fully equivalent supports (A10, 26).

Moreover, both equivalent pedestals were known prior to the '226 patent as established, among other ways, by Petitioner admitting the prior art status of inverted T tubular pedestals for chairs and tables (Req. for Adm. 13) and by the patentee admitting he had seen inverted T tubular pedestals for tables prior to his conception of the '226 patented chair (RA 5-6). In fact, both types of equivalent pedestals for lecture room chair support functions were previously interchangeably used as a mere matter of choice (DXNF, p.32, RA 7-9) by the Howell Co., a direct competitor of Petitioner in such lecture room seating! The '226 patented chair concept constitutes no more than a well known choice of whether to interchange one well known inverted T tubular pedestal for another equivalent well known inverted T round base pedestal in a well known

combination for a well known seat support result. It is no wonder the Sixth Circuit held that

> the ['226] patent in suit is just 'as flimsy and as spurious' as that involved in *Great A. & P. Tea Co.* [*v. the Supermarket Corp.*, 340 U.S. 147, 158 (1950)] (A29)

IV.

REASONS FOR DENYING WRIT

A. THE HOLDING OF ANTICIPATION IN THIS CASE IS AN APPLICATION OF THE WELL RECOGNIZED TEST OF ANTICIPATION TO THE UNREBUTTED FACTUAL FINDINGS.

1. To anticipate, all the claim elements or their equivalents must be found in one single description or structure.

Petitioner has argued that a single prior art teaching must be structurally identical to the claim elements to anticipate and thus invalidate the patent under 35 U.S.C. § 102 for lack of novelty. To the contrary, the Circuit Courts have announced, with some slight variation in language, the test that "[i]n order to anticipate an invention, it is necessary that all the elements of the invention *or their equivalents* be found in one single description or structure *where they do substantially the same work in substantially the same way.*" (Emphasis added.) *Shanklin Corp. v. Springfield Photo Mount Co.*, 521 F.2d 609, 616 (1st Cir. 1975), *cert. den.* 424 U.S. 914 (1976); *Kahn v. Dynamics Corp. of America*, 508 F.2d 939, 943 (2d Cir. 1974), *cert. den.*, 421 U.S. 930 (1975); *W. L. Gore & Associates, Inc. v. Carlisle Corp.*, 529 F.2. 614, 621 (3rd Cir. 1976), insignificant differences; *Butler v. Helms*, 550 F.2d 954 955-6 (4th Cir. 1977); *Hughes Tool Co. v. Ingersoll-Rand Co.*, 437 F.2d 1106, 1108-9 (5th Cir. 1971), *cert den.* 403 U.S. 918, 91 S.Ct. 2230, 29 L. Ed. 2d 696 (1971); *Allied Wheel Prods. v. Rude*, 206 F.2d 752, 760 (6th Cir. 1953);

Amphenol Corp. v. General Time Corp., 397 F.2d 431, 437-8 (7th Cir. 1968); *Greening Nursery Co. v. J and R Tool and Mfg. Co.*, 376 F.2d 738, 740 (8th Cir. 1967); *Pierce v. Muehleisen*, 226 F.2d 200, 203 (9th Cir. 1955); *Scaramucci v. Dresser Indus., Inc.*, 427 F.2d 1309, 1314-16 (10th Cir. 1970). The District Court and Appellate Court applied this well established standard for application in the present case.

Petitioner has attempted to criticize the use of this test on the basis that "the cases provide no definition of what is meant by 'or their equivalents'" (Pet. 11). To the contrary, consistent with the very definition of equivalents given in the test for anticipation, this Court has long provided the same definition for equivalency in patent law as follows:

> If two devices do the same work in substantially the same way, and accomplish the same result, they are the same, *even though they differ in name, form or shape. Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608, 70 S.Ct. 854, 94 L.Ed. 1097 (1950).

The last phrase of the quote was emphasized by the Sixth Circuit in this case in finding that the prior art round base chairs differing only in "foot *shape*" from the '226 patented chair are equivalent or the same as the '226 patent chair for purposes of 35 U.S.C. § 102. (A25) This finding is consistent with the long recognized principle that "differences in configuration only are not patentable". *National Connector Corp. v. Malco Mfg. Co.*, 392 F.2d 766, 770 (8th Cir. 1968), *cert. den.* 393 U.S. 923 (1968). In finding nothing novel in changing a round pin to a flat pin, the 8th Circuit in *National Connector* quoted from *Graham v. John Deere Co.*, 383 U.S. 1, 10 (1966) wherein Justice Clark cited Thomas Jefferson's comment that

> A mere change of form should give no right to a patent, as a high quartered shoe instead of a low one, a round hat instead of a three square, or a square bucket instead of a round one.

Similarly, American's mere change of form from a round plate for a foot to a well known rectangular tube for a foot gives no right to a patent.

2. The Sixth Circuit and Northern District of Ohio Made Lengthy Structural and Functional Comparisons of the Prior Art Chairs to the '226 Patented Chair to Make the Factual Finding of Equivalents.

Petitioner has argued that the opinion in this case in finding anticipation ignored structural comparisons and instead merely held that there was functional equivalency between the prior art round base pedestals and the patented inverted T pedestal with tubular foot. This argument, which does contain Petitioner's admission of functional equivalency between the prior art and the patented chairs (Pet. 6, 9), conveniently overlooks large portions of the opinions by both Courts dealing directly with structural comparisons.

Specifically, the opinions included drawings of the prior art round base center pedestal chairs as well as the '226 patented center pedestal chair. These drawings were explained by the courts in specific detail by describing the structural content of the American round base center pedestal chair, the National Tour Coach center pedestal chair, and the subsequently patented chair. Such description of the prior art chairs applied the reference numerals included in the '226 patent to the prior art chair drawings, thereby to show the direct one-to-one relationship between the structural elements of the prior art round base chairs and the structural elements of the '226 patented chair. (A7-10, 23-25)

Since the round base American chair has been found to be identical to the '226 patented chair except for the shape of the foot, anticipation of the '226 patented chair by the prior art American round base chair under the well

recognized test for anticipation set forth above is established by the following comparison using the trial court's numerals and description to show that the differently shaped pedestal feet are doing the "same work, in substantially the same way to accomplish the same result":

Prior Art Round Base Foot	Tubular Foot in '226 Patent
Foot base plate 16 has fore and aft fasteners 19 relative to the column positioned as required by the bolting pattern to secure the foot to the floor;	Base plate 16a has fore and aft fasteners 19 relative to the column positioned as required by the bolting pattern to secure the foot to the floor;
The fasteners 19 are selectively concealed by removable covers 20, 20A;	The fasteners 19 are selectively concealed by removable covers 20;
Removal of the covers 20, 20A provides tool access to the fasteners 19;	Removal of the covers 20, 20A provides tool access to the fasteners 19;
The base plate 16 is attached to the bottom of a hollow column 15 positioned at the center of the chair.	The base plate 16a and tube 16 are attached to the bottom of a hollow column 15 positioned at the center of the chair.

In unrebutted testimony, Mr. Edwards, National's designer, compared National's prior art round base pedestal foot to the '226 patent foot in accordance with the above chart and stated his opinion of the direct equivalence therebetween (RA 10-13). Such pedestal feet have substantially the same structure, performing substantially the same functions in substantially the same way and are thus equivalent feet under the patent law. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607, 70 S.Ct. 854, 856 (1950).

After making the specific structural analysis of the prior art and patented chairs, the District and Appellate

Courts went on to find that all of the functions for the inverted T pedestal defined in the '226 patent, i.e., aesthetics, ease of cleaning and maintenance, ease and safety of passenger egress and ingress, and increased leg and storage room under the seat, were already present in the round base chair (A8, 9). In this regard, the Sixth Circuit held:

> In our opinion it is patently obvious that the round base seats furnish, in the same manner, that is, by the use of center pedestal floor support, the identical advantages over aisle leg seats. (A25)

Contrary to Petitioner's arguments, this holding is an express statement that the specific prior art structure involved (center pedestal floor supports) provides the same functions in the same manner as the patented center pedestal. This finding is further supported by American selling the round base chair as an option to the subsequently developed inverted T tubular base chair for approximately five years (PX132, RA14) as well as by American arguing to the Patent Office in its patent application directed to the round base center pedestal chair that

> [t]he advantages of such a [round base] construction are apparent: ingress and egress of passengers in both seats is greatly facilitated. Seating comfort is enhanced because of the greater leg room and lack of obstruction, additional space is provided for storage of bulky objects, the aisle is free of foot obstruction, the appearance of the vehicle looking down the aisle is enhanced, etc. (DX SP, RA15)

The finding of anticipation based upon the identical American chair having an equivalent foot is, as the Sixth Circuit recognized herein, a "determination of fact which cannot be disturbed unless clearly erroneous." *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609-10, 70 S.Ct. 854 (1950).

3. The Primary Case Cited by Petitioner Does Not Support Petitioner's Contention of Inconsistency In Decisions, But Instead Supports and Is Consistent With the Courts' Holdings of Anticipation Herein.

Petitioner argues that "the Sixth Circuit decision on anticipation is in conflict with its concurrent [earlier] *Nickola v. Peterson* [580 F.2d. 898 (6th Cir. 1978)] decision . . . ." (Pet. 6) To the contrary, an analysis of *Nickola* shows that indeed it is consistent with the opinions in this case and fully supports the Courts' holdings of anticipation.

Specifically, the Sixth Circuit in *Nickola* indicated that one of the elements of the claimed combination was not present in the best single prior art structure. The finding was stated as follows:

> There was no evidence that gas meters had been mounted on electric meter pedestals before Nickola's invention, i.e. that Nickola's *combination* was old. 580 F.2d 898, 907. (emphasis in original)

In contrast, both Courts in this case have found *the entire combination to be old* in the round base pedestal chairs (All, 27). Therefore, *Nickola* does not apply to the present case.

Moreover, at the conclusion of its discussion of the deficient combination in the prior art, the Sixth Circuit in *Nickola* stated that the proper test for anticipation was "substantial identity" as set forth in *Monroe Auto Equip. Co. v. Heckethorn Mfg. Co.*, 332 F.2d 406, 414 (6th Cir. 1964), *cert. den.*, 379 U.S. 888 (1964). As stated in *Monroe*, substantial identity for anticipation means that "all the elements of the invention or their equivalents be found in one single description or structure where they do substantially the same work in substanitally the same way." In contrast to Petitioner's arguments that such test is dicta (Pet. 11), the 6th Circuit in *Monroe* specifically applied this test in finding that a prior art vehicle suspension device invalidated the vehicle suspension device claimed in the patent in that suit as follows:

> These facts clearly demonstrate that the Knoedler device was prior to Patent '938, that it consisted of substantially the same elements operating in the same manner, and that it was sufficiently reduced to a public use. We hold that these facts establish anticipation . . . .[2]

The courts in this case applied the same test. Therefore, the anticipation holdings in this case are an application of such well recognized test to the unrebutted structural and functional findings directly equating the prior art round base chairs to the '226 patented chair. Accordingly, the petition does not present an issue under 35 U.S.C. § 102 requiring review by this court.

B. IN FINDING THE '226 PATENT CLAIMS OBVIOUS, THE DISTRICT AND APPELLATE COURTS APPLIED THE TESTS AND GUIDELINES FOR OBVIOUSNESS ANNOUNCED BY THIS HONORABLE COURT.

In finding obviousness, the Trial and Appellate Courts carefully followed the basic obviousness tests of *Graham v. John Deere* by extensively analyzing the scope and content of the prior art, by comparing the prior art to the '226 patent to determine if any differences exist therebetween, by determining the level of skill in the art, and by then finding obviousness and thus invalidity under 35

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[2] For other exemplary cases using equivalents to find anticipation, see *Kahn v. Dynamics Corp. of America;* supra; *Hughes Tool Co. v. Ingersoll-Rand Co.*, supra; *Kiva Corp. v. Baker Oil Tools, Inc.*, 412 F.2d 546, 552-3 (5th Cir. 1969), *cert. den.* 396 U.S. 927, 90 S.Ct. 262, 24 L.Ed. 2d 226 (1969); *Amphenol Corp. v. General Time Corp.*, supra; *Deep Welding, Inc. v. Sciaky Bros.*, 417 F.2d 1227, 1234, 1240 (7th Cir. 1969), *cert. den.* 397 U.S. 1037 (1970); *Pierce v. Muehleisen*, supra; and *Scaramucci v. Dresser Indus., Inc.*, 427 F.2d 1309, 1314-16 (10th Cir. 1970).

U.S.C. § 103 against this background. Petitioner has not alleged any failure by the Courts in this case to follow these primary tests. Instead, Petitioner is asking this Court to reanalyze the facts contained in the extensive record as they allegedly relate to one of the secondary considerations of obviousness.

Specifically, Petitioner contends that the Sixth Circuit erred by disregarding evidence of ". . . actual unobviousness by an actual person [Mr. Edwards of National] skilled in the art at the time of the invention . . ." (Pet. 12) Such contention improperly ignores specific evidence that the invention was in fact obvious to Mr. Edwards, improperly ignores evidence and factual findings by the Courts as to what other people of ordinary skill in the art were doing showing obviousness, and improperly uses its biased interpretation of the limited facts to manufacture an alleged inconsistency with the case law on secondary considerations of obviousness when, in fact, no such inconsistency exists. Respondent recognizes the inadequacies of petitioner's contention because of the oft repeated admonition that the Supreme Court does

> not grant certiorari to review evidence and discuss specific facts. *United States v. Johnson*, 268 U.S. 220, 227 (1925).

However, Respondent feels compelled briefly to discuss a few facts that show the clear obviousness of the '226 patent to one and all of ordinary skill in the art as emphatically found by both courts.

1. The Facts Establish That the Substitution of One Well Known Pedestal Foot For Another Well Known Pedestal Foot is a Mere Matter of Obvious Choice Having No Patentable Merit.

> Making a known choice to meet known requirements . . . is no more ingenious than selecting the last piece to put into the last opening of a jig saw puzzle. It is not invention. *Sinclair & Carrol Co. v. Interchemical Corp.*, 325 U.S. 327, 335, 89 L.Ed. 1644, 65 S.Ct. 1143 (1945)

The following established activities of National, Heywood Wakefield, American and Howell show that the patentee in this case was indeed making such a previously known choice for previously known seating requirements.

In 1959 and 1963, Mr. Edwards of National designed a tubular foot with selectively concealed fasteners passing through the base plate to secure these chair pedestals to the floor, with such fasteners being selectively concealed by removable covers. (DX VQ, VW, RA 16 and DX FJ, RA 17). Although not commercially manufactured because of the relative cost of stainless steel at the time (RA 18), these National tubular foot designs have been clearly established by dated drawings (RA 17, DX DJ), by pictures of prototypes (RA 16), and by advertising that was distributed to the industry (DX DJ) including American (RA 19-21). This suit has the effect of attempting to keep Mr. Edwards from using his own previously developed tubular foot in a well known seat combination, thereby to diminish improperly the known resources available to skillful men. *Great A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 152, 95 L.Ed. 162, 71 S.Ct. 127 (1950).

Furthermore, in designing National's accused chair, Mr. Edwards, in unrebutted testimony, stated that his work on the center pedestal project was sporadic and did not include very many designs (RA 22-25), that he did not know about and did not copy American's center pedestal seat (RA 26-28), and that he saw an inverted T tubular pedestal on the prior art Mitchell conference table in the engineering department of National and merely used such Mitchell pedestal design concept to support his bus seat (RA 29-31). Such independent design, using as a matter of choice the prior art Mitchell inverted T tubular

pedestal (PX 68, RA 32, DX AT, RA 33), further establishes obviousness since the accused seat was independently developed in response to market stimuli without assistance from the patent owner. *Continental Oil Company v. Whitco Chemical Corp.*, 484 F.2d 777, 782 (7th Cir. 1973) and *Custom Paper Prods. Co. v. The Atlantic Paper Box Co.*, 469 F.2d 178, 180 (1st Cir. 1972).

Similarly, in 1968, Heywood Wakefield, a manufacturer of various types of furniture and transportation seating (RA 34), was asked by the Budd Company to build chairs for the Plane Mate buses used to convey passengers between the airport terminal and the airplanes. Knowing the parameters for this project, Heywood Wakefield specifically considered using either inverted T tubular pedestals or inverted T cast pedestals to support the frames and fixed back seating required (RA 35-48). To reduce weight and projected costs, the choice was to make the Plane Mate pedestal as a casting rather than a tubing fabrication (RA 41). Such Heywood Wakefield inverted T cast pedestal included a tubular upright column, an elongated hollow foot formed as a channel with base plates at each end, and fasteners recessed in the base plates and selectively concealed by removable covers (DX CL, pp 1, 7, RA 49, 50, DX TA, RA 3). The District and Appellate Courts agreed that the Heywood Wakefield inverted T pedestal and the inverted T tubular pedestal of the '226 patent have almost identical structure (A 12, 27), as clearly supported by Heywood Wakefield merely choosing one over the other for commercial reasons and by American's own choice process.

In this regard, prior to the patented tubular pedestal, American had designed a channel shaped cast foot with selectively covered fasteners at its ends (PX 156). In making the "conception sketch" of the '226 patent pedestal, Mr. Barecki, the patentee, merely chose to draw superimposed fabricated tubes over the previously developed

cast pedestal. In fact, although Petitioner now attempts to emphasize the alleged importance of a tubular foot, this emphasis is inconsistent not only with Mr. Barecki's admission that tubes, at the time of the invention, were equivalent to channels (RA 51) but also with the original claims presented to the Patent Office by Petitioner in the '226 application which did not specifically claim a "tube" at all but instead merely claimed an elongated hollow foot (PX 119, RA 52-3). This "elongated foot" hollow foot definition would encompass many structural forms, including, of course, the prior art cast foot of Heywood Wakefield's inverted T Plane Mate pedestal.

Finally, the Howell Company, a competitor of American, manufactured lecture room seating consisting of plural fixed back seats mounted on a beam frame supported by spaced pedestals (DX TA, RA 3). One such Howell pedestal consisted of an upright tubular column with an elongated rectangular base plate bolted to the floor (DX NF, RA 9)[3], while an alternative Howell pedestal consisted of an inverted T tubular pedestal bolted to the floor (DX TA, RA 3, DX NF, RA 9, RA 54-59). These optional pedestals were illustrated right next to one another under the caption "leg detail" on page 32 of Howell's 1966 advertising brochure (DX NF, RA 9). Clearly, the use of the rectangular base pedestal or the inverted T tubular pedestal as thus illustrated in Howell's catalog was a mere matter of routine choice in 1966 for Howell and/or its customers. This is exactly the pedestal choice made approximately four years later by the patentee in going from American's prior round base pedestal to the well known inverted T tubular pedestal, which well known

[3] This "rectangular base" pedestal is identical to American and National's round base pedestals described above except for being rectangular (like the '226 tubular foot) rather than round and for including one fore and one aft floor fastener (like the '226 tubular foot) rather than plural fore and aft floor fasteners.

choice is clearly devoid of any patentable merit. *Sinclair & Carrol Co. v. Interchemical Corp.*, supra.

In other words, replacing the round base pedestal in American's prior art round base chair with the admittedly well known inverted T tubular pedestal of the prior art, while otherwise maintaining all the teachings of the primary round base chair (including floor fasteners through the base plate selectively concealed by removable covers) is a well known matter of choice and thus an obvious combination of teachings under 35 U.S.C. § 103. This choice is the "work of a skillful mechanic[4], not that of an inventor". *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 47 L.Ed. 2d 784, 96 S.Ct. 1532 (1976).

2. The Case Law Cited By Petitioner, Which Requires The Patent To Be Judged Against The Full Context of The Prior Art, Establishes The Irrelevancy of Edwards Later Sporadic Work And is Consistent With The Decisions In This And Other Cases.

With respect to the obviousness holdings as they relate to secondary considerations of patentability (Point II of Petition), petitioner limits its alleged error to the contention that the courts "disregarded evidence that the device was actually unobvious to one [Edwards] skilled in the art." (Pet. 11) Petitioner cites *Illinois Tool Works, Inc. v. Sweetheart Plastics, Inc.*, 436 F.2d 1180, 1182 (7th Cir. 1971) and *Graham v. John Deere*, 383 U.S. 1, 12, 86 S.Ct. 684 (1966), apparently for support of its proposition that the "abortive" work of one man is central to the obviousness-unobviousness finding. Quite to the contrary, such

[4] This choice was previously presented to customers of Howell; therefore, the choice didn't even require a "skillful mechanic" level of experience for its ready resolution. Mr. Nystedt of Howell testified that the '226 patent consisted of obvious structure undoubtedly within the engineering skill of Howell in 1963 (RA 60-61).

cases indicate that the efforts and work of one man skilled in the art should be evaluated and judged in the context of the efforts and work of all men skilled in the art during the relevant time frame.

In this regard, the 7th Circuit in the *Illinois Tool Works* case in determining the obviousness issue held:

> We believe it is far more telling that not only did Davis fail to outrace Edwards to the marketplace or the patent office with an operative product like the '360 invention, but Miller, Politis (who introduced Edwards to sheet thermoforming of plastic cups) and defendants' witness Pfohl also failed to do so as apparently did all others skilled in the art. 436 F.2d at 1187.

Thus Davis' abortive efforts were measured in the more important overall context of the abortive efforts of everyone else in the industry.

In *Graham v. John Deere,* unsuccessful attempts to develop the device began in approximately 1947 and continued thereafter until the patented device consisting of small nontechnical mechanical differences over the prior art was developed in 1956. This Court determined that such nontechnical differences were rendered apparent by a 1953 prior art patent and that

> unsuccessful attempts to reach a solution to the problems confronting Scoggin before that time [1953] became wholly irrelevant.

Again, the previous unsuccessful efforts were judged in the context of the entire body of art and of those skilled in that art to determine the irrelevance of the unsuccessful efforts.

Applying the *Illinois Tool Works* and *Graham v. John Deere* cases to the facts of this case, even if Edwards' design attempts after 1970 showed unobviousness to him, which Respondent strongly denies for the reasons set forth above, such attempts are irrevelant since they occurred after

Howell's 1966 chairs, Heywood Wakefield's 1969 chairs, and American's 1969 chairs found clearly to invalidate the patent. The evidence establishes that people skilled in the art did not previously have unsuccessful attempts or failures but instead rapidly developed equivalent anticipating chairs having inverted T round pedestals that could be interchanged with the well known inverted T tubular pedestal as a matter of known choice in the art prior to the '226 patent.

In making specific findings regarding the full scope of prior art chairs, the District and Appellate courts fully evaluated the relevant evidence regarding the secondary consideration questioned by American, i.e. the prior design attempts of others on center pedestal chairs. Therefore, the opinions in this case fully considered and made findings on the relevant secondary consideration evidence questioned by Petitioner and thus complied with the footnote suggestion in *Nickola v. Peterson*, 580 F.2d 898, 911 (6th Cir. 1978), that such information should normally be considered.[5] Furthermore, in a case where obviousness is clear, as the 6th Circuit held herein after characterizing the '226 patent as "flimsy and spurious" (A 29), secondary factors cannot tip the scales toward patent validity. *Graham v. John Deere Co.*, 383 U.S. 1, 35-36, 86 S.Ct. 684 (1966).

[5] Petitioner argues that the Sixth Circuit held that the "District Court did not consider all the relevant evidence in making its determination of obviousness-nonobviousness". (Pet. 14). To the contrary, the Sixth Circuit merely said that the District Court didn't consider and make findings on specific limited contentions by Petitioner. Clearly, the District Court considered all the evidence advanced during the lengthly trial and, for the reasons set forth herein, made lengthly findings of fact and conclusions of law on the point of alleged error. In any event, "the trial court need not make specific findings on all facts and evidentiary matters brought before it, but need find only the ultimate facts necessary to reach a decision in the case." *United States v. F. D. Rich Co., Inc.*, 439 F.2d 895, 899 (8th Cir. 1971).

"Any theory that secondary considerations must be given weight before a determination of obviousness can be made was laid to rest in *Sakraida v. Ag Pro, Inc.*, 425 U.S. [273] at 282 [1976]". *Digitronics Corp. v. N.Y. Racing Assn., Inc.*, 553 F.2d 740, 748 (2d Cir. 1977), *cert. den.*, 435 U.S. 933 (1977). See *Tokyo Shibaura Elec. Co. v. Zenith Radio Corp.*, 548 F.2d 88, 94-5 (3d Cir. 1977).

For the reasons set forth above, Respondent respectfully submits that the opinions herein as to obviousness are consistent with the decisions of this Court and with the decisions of the circuits as they relate to the limited error alleged. Review by this Court is accordingly unnecessary.

C. PETITIONER FAILS TO RAISE ANY RULE 19 REASONS FOR GRANTING CERTIORARI TO RECONSIDER THE HOLDINGS OF OBVIOUSNESS BASED ON LACK OF SYNERGISM.

Petitioner argues that

> in face of the facts that the patented seat was actually obvious to one skilled in the art, it was unnecessary for the court to consider whether the claimed combination produced a synergistic effect. (Pet. 17)

Such argument is deficient in three respects. First, it is premised on Petitioner's interpretation of only limited facts which are irrevelant and unsupported as discussed above. Second, it is unsupported by any case law citation. Third, it ignores the admonition of this Court on synergism.

Specifically, this Court has repeatedly made the following admonition since 1950:

> A patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what already is known into the field of its monoply and diminishes the resources available to skillful men . . . Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding inven-

tion in an assembly of old elements. *Great A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 152 (1950).

In heeding this Court's admonition, the District Court found that all the '226 patent claim elements were old, that the claimed combination was old, and that the old elements did not function in any new or different mode in the combination nor provide any new or different result (A 8-13). Based on these findings, the trial and appellate courts held that the '226 patented chair under 35 U.S.C. § 103 was obvious, among other reasons, because it lacked a synergistic result. Such findings and holdings specifically follow and are in conformance with the standards set forth in *Great A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 155, 71 S.Ct. 127, 95 L.Ed. 162 (1950); *Anderson's-Black Rock v. Pavement Salvage Co.*, 396 U.S. 57, 61, 90 S.Ct. 305, 24 L.Ed. 2d 258 (1969) and *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 96 S.Ct. 1532, 47 L.Ed. 2d 784 (1976).

Respondent respectfully submits that the opinions in the present case are consistent with the law of this Court on synergism and that review thereof is inappropriate.

D. PETITIONER HAS CHANGED ITS POSITION BEFORE THIS COURT IN AN ATTEMPT TO RENDER "MOOT" THE FULLY SUPPORTED OPINIONS OF INVALIDITY BASED UPON 35 U.S.C. § 112.

The '226 patent and its file wrapper are admittedly silent regarding any alleged improved energy absorption for the '226 patent. (A 14, 28) Even though the law is well established that undisclosed attributes cannot be relied upon in attempt to support patentability, *Lincoln Engineering Co. v. Stewart Warner Corp.*, 303 U.S. 545, 550 (1938), the trial court received, in its words, "a great deal

of testimony and evidence" (A 13) on the energy absorption issue but then made the following factual findings:

> The asserted inherent safety features of the seat design of the '226 patent relate to the upright column and foot design and would necessarily relate to the tensile strength, gauge, size, shape and type of material used in said upright column and foot. The patent is silent as to any such references. (A 13)

Based on these findings, the trial court held that "[i]f plaintiff bases patentability of its patent on these [energy] absorption features, the patent is invalid as failing to particularly point out and distinctly claim that which it alleges is the subject matter of its patent pursuant to Title 35 U.S.C. § 112" (A 14). Contrary to Petitioner's arguments (Pet. 19), this holding is consistent with and directly reflects the language of the second paragraph of 35 U.S.C. § 112 which reads "the specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention." (Emphasis added.)

On this issue, the Sixth Circuit held the '226 patent invalid "because it failed to describe particularly that which was claimed to be invented under 35 U.S.C. § 112." (A 29) With respect to the allegations of "inherent" improved energy absorption or crashworthiness, the Sixth Circuit found that it had not been proved by Petitioner and that it was no more than afterthought by Petitioner's counsel (A 28).

In attempting to overcome such holdings, Petitioner argues that Mr. Edwards testified that he could construct the chair shown in the patent. (Pet. 19) While Mr. Edwards did so state, such testimony is irrelevant to the 35 U.S.C. § 112 issue for two reasons. First, he did not testify as to what materials, gauges and shapes would be used in such construction and whether it would have any different

energy absorption characteristics than other seats built by him. Second, the quoted portion of § 112 makes it incumbent on the patentee, Mr. Barecki, to define the alleged improved energy absorption characteristics of the chair as that "which the applicant regards as his invention." The patentee failed to make this "energy absorption" definition.

Petitioner has not raised a reason under Rule 19 to review this holding of invalidity. Instead, rather than trying to buttress patentability on the undisclosed and unproven inherent energy absorption as attempted at the District Court and 6th Circuit, Petitioner has now changed its position allegedly to render the indefiniteness issue "moot" as a result of "Petitioner's disclaimer of basing any patentability on such characteristics." (Pet. 18) In the first place, such disclaimer is ineffective since the 6th Circuit's holding finds the patent invalid under 35 U.S.C. § 112 because of the absence of energy absorption definition irrespective of Petitioner's intentions in presenting this evidence and irrespective of its contentions with respect to such evidence. Secondly, such disclaimer presents a position to this Court which is inconsistent with the position considered below; therefore, Respondent submits that the disclaimer is ineffective and should not be considered under the rule precluding inconsistent positions in the same action. 28 Am. Jur. 2d, *Estoppel and Waiver,* § 69 citing *Norfolk S.R. Co. v. Chatman,* 244 U.S. 276, 61 L.Ed. 1131, 37 S.Ct. 499 (1917). However, even if the disclaimer is considered, the invalidity issue under 35 U.S.C. § 112 would still not be "moot" since the patent is further invalid under such section for overclaiming.

Specifically, the '226 patent claims are all directed to the chair consisting of the entire old combination of seats, frame, wall mount and pedestal rather than particularly pointing out and distinctly claiming the alleged improvement in the foot as required by 35 U.S.C. § 112. In *Lincoln*

Engineering v. Stewart Warner Corp., 303 U.S. 545, 549 (1938), this Court held:

> . . . having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function in its claimed combination. The patent is therefore void as claiming more than the applicant invented.

Cf. *Holstensson v. V-M Corp.,* 325 F.2d 109, 122-126 (6th Cir. 1963) and *Stuckenborg v. Teledyne, Inc.,* 441 F.2d 1069 (9th Cir. 1971), *cert. den.* 404 U.S. 852 (1971). In other words, it is statutorily incumbent upon an applicant for an improvement to a combination to particularize what is old and what is new and to limit the claims to what is new. 35 U.S.C. § 112. *Henry J. Kaiser Co. v. McLouth Steel Corp.,* 257 F.Supp. 372 (E.D. Mich. 1966), *aff'd.,* 400 F.2d 36, 51 (6th Cir. 1968). This was not done by Petitioner and its failure in this regard renders the '226 patent ". . . void as claiming more than the applicant invented." *Lincoln Engineering,* supra.

With respect to 35 U.S.C. § 112, Petitioner has improperly changed its position from that presented to the District and Appellate Courts without raising a Rule 19 ground for review by this Court. Furthermore, the Sixth Circuit's holding of invalidity under 35 U.S.C. § 112 is further supported by the clearly applicable doctrine of overclaiming.

V.

CONCLUSION

For the reasons set forth above, the Sixth Circuit decision in this case is consistent with the decisions of other courts and properly applies the well recognized tests for the issues presented to the facts established in the lengthy

record. Therefore, there is no reason for this court to review the Sixth Circuit's decision, and accordingly, Respondent respectfully submits that the Petition for Writ of Certiorari to the Sixth Circuit should be denied

Respectfully submitted,

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